



## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,742	03/20/2000	Paul Roben	11390-002001	5781

20995 7590 01/24/2002

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EXAMINER

WOITACH, JOSEPH T

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 01/24/2002

Paper No.

### Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 1-7-02 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on September 8, 2000 (see *65 Fed. Reg. 54603*, Sept. 8, 2000, and *1238 O.G. 77*, Sept. 19, 2000). In order for the amendment to be compliant, applicant must supply the following omissions or corrections in response to this notice.

THE FOLLOWING ITEMS ARE REQUIRED FOR COMPLIANCE WITH RULE 1.121 (APPLICANT NEED NOT RE-SUBMIT THE ENTIRE AMENDMENT);

- ☐ 1. A clean version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(ii).
- ☐ 2. A marked up version of the replacement paragraph(s) is required. See 37 CFR 1.121(b)(1)(iii).
- ☐ 3. A clean version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(i).
- ☐ 4. A marked up version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(ii).

Explanation: See Examiner's Action

(LIE: Please provide specific details for correction to assist the applicant. For example, "the clean version of claim 6 is missing.")

For further explanation of the amendment format required by 37 FR 1.121, see MOEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/dcom/olia/pbg/sampleaf.pdf>. A condensed version of a sample amendment format is attached.

- ☐ **PRELIMINARY AMENDMENT:** Unless applicant supplies the omission or correction to the preliminary amendment in compliance with revised 37 CFR 1.121 noted above within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

- ☒ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above mentioned reply appears to be *bona fide*, applicants is given a TIME PERIOD of ONE MONTH or THIRTY DAYS from the mailing of this notice, whichever is longer, within which to supply the omission or correction noted above in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

  
Legal Instruments Examiner(LIE)

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### **DETAILED ACTION**

Please note that the Examiner of record and art unit has changed. The Examiner of record is now **Joseph T. Voitach** and the group art unit is now **1632**.

Applicants preliminary amendment filed July 7, 2001, paper number 3 has been received and entered. Claim 19 was amended. Applicants amendment filed January 7, 2002, paper number 11, has been received and entered. Claim 55 has been added. Claims 1-55 are pending and currently under examination.

### ***Election/Restriction***

The reply filed on January 7, 2002 is not fully responsive to the prior Office action because of the following omission(s) or matter(s):

Applicant's election of species for the three separate domains set forth in the previous office action in Paper No. 10 is acknowledged, however three specific distinct species were not elected. Applicants have indicated that their election of species is set forth in newly added claim 55, wherein (a) the first domain covalently and non-specifically binds, (b) the second domain comprises a labeling domain, and (c) the third domain is the cleavable chemical moiety sulfosuccinimidyl-2-(biotinamido)ethyl-1,3-dithiopropionate. Only the election of the specific species of (c) the third domain comprising a specific cleavable chemical moiety is compliant. As for (a) the first domain, Applicants are required to elect a specific species set forth on pages 14,

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line 26 to page 15, line 25 of the instant specification, for example; 1. a sulfo-NHS ester group, 2. cabodiimide, 3. carbamoylonium, 4. sulphydryl reactive moieties, or 5. carbohydrate-binding moieties. As for (b) the second domain, Applicants are required to elect a specific species set forth in claims 10-12 or 29-31, for example; 1. biotin, 2. a polypeptide, 3. a fluorescent molecule, 4. a colorimetric agent, 5. radionuclide, 6. a naturally organic molecule, 7. a synthetic organic molecule, and 8. a chelate. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Clark, can be reached at (703)305-4081.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist Patsy Zimmerman whose telephone number is (703)308-8338.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Voitach

  
DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1800-1630